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LPIN THE UNITED STATES PATENT AND TRADEMARK OFFICEApplicant(s): Paszty *et al.*

Serial No.: 09/818,954

Group Art Unit No.: 1647

Filed: March 27, 2001

Examiner: L. Spector, Ph.D.

For: BETA-LIKE GLYCOPROTEIN
HORMONE POLYPEPTIDE AND
HETERODIMER

FAX RECEIVED

SEP 19 2002

Docket No.: A-676B

GROUP 1600

RESPONSE TO RESTRICTION REQUIREMENTAssistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Restriction Requirement dated September 3, 2002 (Paper No. 8) with a one (1) month deadline for response set to expire on October 3, 2002, Applicants hereby elect Group I with traverse. In the Restriction Requirement, restriction is required between the following Groups:

- I. Claims 1-8, 10, 11, 47-51, 61 and 65, drawn to nucleic acids, vectors, host cells, expression, and monomeric fusion proteins, classified in Class 435, subclass 69.7;
- II. Claims 9, 13-17 and 41-46, drawn to protein and homodimer thereof, and compositions thereof, classified in class 530, subclass 350;
- III. Claims 12, drawn to an assay using transformed cells, classified in class 435, subclass 7.12;
- IV. Claims 18-36, 39, and 40, drawn to antibodies to β 10 and hybridoma cells, classified in class 530, subclass 387.9;

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being facsimile transmitted to the United States Patent and Trademark Office on the date shown below:

September 19, 2002
Date

Christina A. Yustice

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- V. Claims 37 and 38, drawn to method of treatment using antibodies to homodimeric protein, classified in class 424, subclass 130.1;
- VI. Claim 52, drawn to method of treatment using protein, classified in class 514, subclass 2;
- VII. Claims 53 and 54, drawn to a diagnostic assay for protein, classified in class 435, subclass 7.1;
- VIII. Claim 55, drawn to a device comprising a membrane and cells expressing protein, classified in class 435, subclass 382;
- IX. Claim 56, drawn to a binding assay using protein, classified in class 435, subclass 7.1;
- X. Claims 57 and 91, drawn to gene therapy, classified in class 514, subclass 44;
- XI. Claim 58, drawn to a transgenic animal, classified in class 800, subclass 8;
- XII. Claims 59-60, 66, 92 and 93, drawn to heterodimeric protein, classified in class 530, subclass 350;
- XIII. Claim 67, drawn to assay for compounds that modulate heterodimer activity, classified in class 435, subclass 7.2;
- XIV. Claims 68-71 and 73-86, drawn to antibodies to β 10 heterodimers, classified in class 530, subclass 387.9;
- XV. Claims 72, 96, 97 and 99, drawn to immunoassay for heterodimer, classified in class 436, subclass 501;
- XVI. Claims 87-90, drawn to a method of treatment using a heterodimer, classified in class 514, subclass 2;
- XVII. Claims 87-90, as drawn to a method of treatment using antibodies to a heterodimer, classified in class 424, subclass 130.1;
- XVIII. Claims 94 and 95, drawn heterodimer fusion protein, classified in class 530, subclass 350;
- XIX. Claim 98, drawn to a device comprising a membrane and cells expressing heterodimer protein, classified in class 435, subclass 382.

In response thereto, Applicants hereby elect Group I with traverse.

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The present invention relates to a novel beta-like member of the glycoprotein hormone family. Applicants submit that the subject matter of the instant claims is sufficiently related that it would not require unduly burdensome searching on the part of the Patent and Trademark Office to search all of the groups recited in the Restriction Requirement.

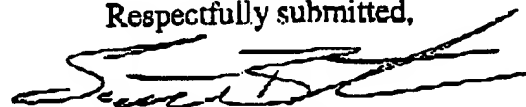
MPEP §803 states that "there are two criteria for a proper requirement for restriction between patentably distinct inventions: A) the inventions must be independent or distinct as claimed; and B) there *must be a serious burden on the examiner* if restriction is required." (emphasis added). Although the Restriction Requirement asserts that restriction is required for the present application under 35 U.S.C. §121, it does not offer any support or reasons as to any such serious burden on the Patent and Trademark Office.

For example, the claims of Group I recite polynucleotide sequences that encode polypeptides assigned to Group II. Because the polynucleotides of Group I are acknowledged to encode the polypeptides of Group II, the polynucleotides could thus be examined along with the polypeptides encoded thereby without undue burden. The advanced state of bioinformatics and indexed sequence databases presently allows such searching to be rendered without unduly burdening the searching authority. Applicants thus submit that there would be no serious burden on the Patent and Trademark Office if restriction were not required.

Nevertheless, Applicants hereby elect Group I, claims 1-8, 10, 11, 47-51, 61 and 65, directed to nucleic acids, vectors, host cells, expression, and monomeric fusion proteins, classified in Class 435, subclass 69.7, with traverse.

It is acknowledged that the non-elected claims will be withdrawn from further consideration, but that Applicants reserve the right to pursue them in continuation or divisional applications at a later time.

Respectfully submitted,



Scott N. Bernstein
Attorney for Applicants
Registration No: 38,827
Phone: (805) 447-4128
Date: September 19, 2002

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Please send all future correspondence to:

US Patent Operations/ SNB

Dept. 4300, M/S 27-4-A

AMGEN INC.

One Amgen Center Drive

Thousand Oaks, California 91320-1799